

REMARKS

In the communication mailed March 17, 2006 the Examiner required restriction between six patently distinct species. The species elected was that of Figures 1A, 1B, 6A, and 6B. Figures 1A and 1B show fasteners connecting fastenable material 18 and 19, described as pine wood. Figures 6A and 6B show fasteners connecting shelves 111 to supports 114. Applicant identified the corresponding claims as claims 1-12, 15-18, 26-28, 31-36, 38-42, and 45.

Examiner has reconsidered the earlier restriction and now identifies two allegedly distinct inventions. The first class is drawn to a fastener and the second class is drawn to knockdown furniture using this fastener.

The Examiner does not actually apply this fastener/furniture distinction and seems to partition claims according to some unstated standard of abstractness. Revealing this abstractness, the Examiner does not consider claims 26-28, 34-36, 38-42 and 45 as part of the new fastener class.

Now, the Examiner is willing to consider as part of the fastener class, claim 31 which recites "the fastenable material is a support," but not claims 27, 28 and 40 which recite the fastenable material is a "structural piece." This action is seen as arbitrary and done without explaining how some claims are "fastener" claims while other claims are "furniture" claims. Moreover, it is not understood why the term "structural piece" cannot include the structural pieces of furniture. On the other hand, it is not understood why a "support" is limited to the field of furniture and does not apply as well to engine mounts, telephone poles, camera

tripods, aircraft landing gear, traffic signs, etc.

The refusal to consider claims 35 and 36 as part of the fastener class is also not understood. Apparently those claims are considered part of the "furniture" class for stating that the fastenable material has a "prong receptor." Regarding claims 38, 39 and 42, as far as the undersigned can tell, the only reason these three claims were refused entry into the "fastener" class is their dependency on claim 35.

The undersigned's difficulty in understanding why a "prong receptor" is not part of the "fastener" class is compounded by the fact that every embodiment has a prong receptor. For this reason, restriction seems most inappropriate.

The Examiner segregates the claims using the argument that the "fastener" claims are a subcombination in the "furniture" claims (combination claims). Of course, normally an applicant is permitted to prosecute claims to a subcombination with claims to at least one combination that includes that subcombination. Thus, MPEP §806.05(c)II provides:

When an application includes a claim to a single subcombination, and that subcombination is required by plural claimed combinations that are properly restrictable, the subcombination claim is a linking claim and will be examined with the elected combination (see MPEP § 809.03).

See also MPEP 806.05(c).¹

¹Subcombination Essential to Combination Absp/Bsp No Restriction

Where a combination as claimed **> requires< the details of *> a< subcombination as separately claimed, there is > usually< no evidence that combination Ab^{sp} is patentable without the details of B^{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. This situation can be diagrammed as combination AB^{sp} ("sp" is an abbreviation for "specific"), and subcombination B^{sp}. Thus the specific characteristics required by the subcombination claim B^{sp} are also required by the combination claim. > See MPEP § 806.05(d) for situations where two or more subcombinations are separately claimed.<

Because restriction between a combination and subcombination is extraordinary, such a restriction is only proper when two-way distinctness occurs. The two-way distinctness test is set forth in MPEP §806.05(c) as follows:

To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary . . .

....
The inventions are distinct if it can be shown that a combination as claimed:
(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

When these factors cannot be shown, such inventions are not distinct.

While the Examiner seems prepared to argue distinctness in one direction (the fastener has utility in materially different combinations), is the Examiner actually arguing distinctness in the other direction? Specifically, is the Examiner arguing that fastening to a "structural piece" might be patentable if done with an ordinary fastener, e.g. a bolt? If so, the Examiner would then effectively argue that bolting furniture pieces together may be patentable.

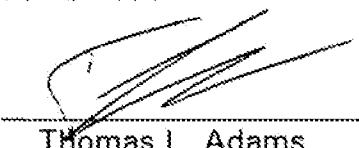
Turning to claims 26, 34, 41 and 45, the Examiner classifies them as "furniture" because they recite shelves. (Of course shelves are built into airplanes, baby strollers, vending machines, etc.; not just furniture). Once again, the Examiner cannot convincingly argue that bolting shelves together is possibly patentable. Also, Applicant does note that originally the Examiner grouped the shelves of Figure 6A with the fastener of Figure 1.

Accordingly, the Examiner is respectfully requested to reconsider the claim groupings set forth in the last communication dated November 22, 2006. Applicant maintains that a proper grouping of claims would be: Claims 1-12, 15-18, 26-28, 31-

36, 38-42, and 45.

In any event, Applicant elects with traverse the first "invention" identified by the Examiner as Group I and associated by the Examiner with claims 1-12, 15-18, and 31-33.

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